UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,555	08/05/2003	Takashi Ohno	1405.1073	7151

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EXAMINER
WHIPPLE, BRIAN P

ART UNIT	PAPER NUMBER
2152	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/633,555	OHNO ET AL.
	Examiner	Art Unit	
	Brian P. Whipple	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 August 2003</u>.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-13</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☒ All   b) ☐ Some * c) ☐ None of:

       1. ☒ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date <u>07/20/2006</u>.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-13 are pending in this application and presented for examination.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 claims a client administration program, software per se, which is merely functional descriptive material. A program fails to fall into any of the four statutory classes of invention: process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 2 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.   As to claim 2, the meaning of "the decision step deciding all of a plurality of

watcher clients of the first client to be identifier notification recipients according to the

change of the identifier of the first client" is unclear. The examiner interpreted this as

"the decision step **further comprising** deciding all of a plurality of watcher clients of the

first client **are** to be identifier notification recipients according to the change of the

identifier of the first client" for the purposes of this examination.

7.   As to claim 13, the use of and/or renders the claim indefinite as it is unclear if the

applicant is claiming the language before the and/or, the language after the and/or, or

both. The examiner interpreted and/or as and for the purposes of this examination.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

9.   Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugano

et al. (Sugano), U.S. Patent No. 6,205,478 B1.

10.   As to claim 1, Sugano discloses a client administration method of administering a

group of clients (Abstract, ln. 1-3), each client providing presence information (Col. 7, ln.

47-49), the method comprising:

a presence-storing step of accepting a setting of presence information of the

clients including a first client, and storing the presence information client by client (Col.

7, ln. 40-43 and 47-49; Col. 19, ln. 2-6);

a notification recipient-storing step of storing identifiers of watcher clients for

respective clients, each of the watcher clients being provided with the presence

information of at least one of the clients in the clients group (Col. 16, ln. 28-30; Col. 18,

ln. 65-67; Col. 19, ln. 1-2; Col. 27, ln. 55-66);

an identifier-changing step of accepting a change of the identifier of the first client

(Fig. 2, item 7; Col. 19, ln. 12-25);

a decision step of deciding a watcher client of the first client or at least one of a

plurality of watcher clients of the first client to be one or more identifier notification

recipients according to the change of the identifier of the first client (Fig. 2, item 7; Col.

19, ln. 12-25; Col. 23, ln. 36-43); and

an identifier-transmitting step of transmitting a new identifier of the first client to

one or more identifier notification recipients decided in said decision step (Col. 22, ln. 6-

18; Col. 23, ln. 36-43).

11.   As to claim 2, Sugano discloses deciding all of a plurality of watcher clients of the

first client are to be identifier notification recipients according to the change of the

identifier of the first client (Col. 18, ln. 4-14; Col. 19, ln. 12-25; an update notification is transmitted to each of the user terminals corresponding to receiving users).

12.   As to claim 3, Sugano discloses a subscriber client-storing step of storing identifiers of subscriber clients so that each subscriber client is associated with at least one client that provides the presence information thereto, the subscriber client being provided with the presence information of at least one client of the clients group (Col. 7, ln. 47-49; Col. 16, ln. 28-30; Col. 18, ln. 65-67; Col. 19, ln. 1-2; Col. 27, ln. 55-66); and

        said decision step deciding a client to be an identifier notification recipient, the client being both a watcher client of the first client and a subscriber client of the first client (Col. 23, ln. 36-43).

13.   As to claim 4, Sugano discloses a presence-notifying step of notifying the first client's watcher client of new presence information according to the setting of the presence information (Col. 7, ln. 47-49; Col. 26, ln. 12-41);

        a notification history-storing step of storing a notification history of the presence information (Col. 9, ln. 25-29; Col. 22, ln. 65-67; Col. 23, ln. 1-3); and

        said decision step extracting at least one of a plurality of watcher clients of the first client based on the notification history, and deciding to be one or more identifier notification recipients (Col. 18, ln. 10-14; Col. 19, ln. 12-25; an update notification is transmitted to each of the user terminals corresponding to receiving users who

previously received a corresponding transmitted UIO; transmitting based on previous

recipients is a decision step based on notification history).

14.   As to claim 5, Sugano discloses a messaging step of administering distribution of

text messages exchanged between the clients (Fig. 3; Col. 21, In. 39-48);

       a distribution history step of storing a distribution history of distributed text

messages (Fig. 3; Fig. 4; Col. 9, In. 25-29; Col. 18, In. 10-14; Col. 22, In. 65-67; Col. 23,

In. 1-3); and

       said decision step extracting at least one of a plurality of watcher clients of the

first client based on the distribution history, and deciding to be one or more identifier

notification recipients (Col. 18, In. 10-14; transmitting based on previous recipients is a

decision step based on distribution history).

15.   As to claim 6, Sugano discloses said presence-storing step storing the presence

information of the clients so that the presence information is associated with an access

level, the access level limiting notification recipients of the presence information of the

clients (Col. 19, In. 63-67; Col. 20, In. 1-15);

       said notification recipient-storing step further storing the access level of each

watcher client (Col. 19, In. 63-67; Col. 20, In. 1-5); and

       said decision step deciding a portion of a plurality of watcher clients of the first

client to be the identifier notification recipients based on the access level of each

watcher client (Col. 20, In. 30-61; Level 5 users are not issued a UIO and no items are accessible).

16.   As to claim 7, Sugano discloses transmitting display data for displaying the change of the identifier of the first client to one or more identifier notification recipients (Col. 25, In. 19-36).

17.   As to claim 8, Sugano discloses transmitting attribute information related to the change of the identifier of the first client to one or more identifier notification recipients (Fig. 3; Col. 22, In. 6-18).

18.   As to claim 9, Sugano discloses said identifier-changing step accepting registration of the attribute information (Col. 22, In. 19-22).

19.   As to claims 10, 11, and 12, the claims are rejected for the same reasons as claim 1 above.

20.   As to claim 13, Sugano discloses a client administration method of administering a group of clients (Abstract, In. 1-3), each client providing presence information (Col. 7, In. 47-49), the method comprising:

a presence-storing step of accepting a setting of presence information of the clients including a first client, and storing the presence information client by client (Col. 7, In. 40-43 and 47-54; Col. 19, In. 2-6);

information-storing step of storing client-relationship information for respective clients, the client-relationship information containing one or more identifiers of one or more clients relating to provision of presence information of the first client thereto and/or one or more identifiers of one or more clients relating to a request made by the first client, the request being for provision of presence information of those clients to the first client (Col. 29, In. 4-43);

an identifier-changing step of accepting a change of the identifier of the first client (Fig. 2, item 7; Col. 19, In. 12-25);

a decision step of deciding one or more clients to be one or more identifier notification recipients according to the change of the identifier of the first client, one or more identifiers of one or more clients being contained in the client relationship information stored in association with the first client (Fig. 2, item 7; Col. 19, In. 12-25; Col. 23, In. 36-43); and

an identifier-transmitting step of transmitting a new identifier of the first client to one or more identifier notification recipients decided in said decision step (Col. 22, In. 6-18; Col. 23, In. 36-43).
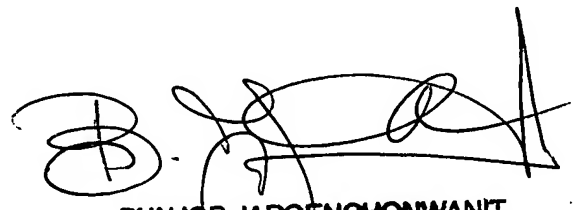
Conclusion

21.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Brian P. Whipple whose telephone number is (571)270-
1244. The examiner can normally be reached on Mon-Thu (7:30 to 5), Fri (8:30 to 5 or
day off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Bunjob Jaroenchonwanit can be reached on (571)272-3913. The fax phone
number for the organization where this application or proceeding is assigned is 571-
273-8300.

Information regarding the status of an application may be obtained from the
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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple
2/17/07

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SUPERVISORY PATENT EXAMINER